

REMARKS

INTRODUCTION

In accordance with the foregoing, claims 1, 3, 10, 11, 16, 18, 19, 24 and 26 are amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-26 are pending and under consideration. Reconsideration is respectfully requested.

ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116

Applicants request entry of this Rule 116 Response and Request for Reconsideration because:

(a) the amendment of claims 1, 3, 10, 11, 16, 18, 19, 24 and 26 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised;

(b) the amendments do not significantly alter the scope of the claims and place the application at least into a better form for appeal. No new features or new issues are being raised; and/or

(c) U.S. Patent No. 6,370,280 to Cok, et al., applied to claims 10, 18, and 26, is newly cited in the final Office Action, and Applicants should be provided the opportunity to present patentability arguments and amendments in view thereof.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered" (emphasis added). Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

REJECTION UNDER 35 U.S.C. §112

In the Office Action at page 2, numbered item 2, claims 3-8 were rejected under 35 U.S.C. §112, second paragraph, for the reasons set forth therein. This rejection is traversed and reconsideration is requested.

As claim 1 has been amended to recite "limitation information," Applicants respectfully submit that there is sufficient antecedent basis for "the limitation information," as recited in

dependent claim 3. Accordingly, Applicants respectfully request that the rejection be withdrawn.

REJECTION UNDER 35 U.S.C. §102

In the Office Action at pages 2-4, numbered item 5, claims 1, 2, 9, and 11-17 were rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 5,103,490 to McMillin. This rejection is traversed and reconsideration is requested.

Independent claim 1 is directed to a data converting apparatus. Independent claim 1 has been amended to recite, in relevant part, "a limiting part limiting use of the single set of superimposed image data in accordance with limitation information showing a limitation of use of the single set of superimposed image data." Further, amended independent claim 1 recites that "the limitation information includes a first permission of the user to initiate the superimposing by the superimposing part, a second permission of a user to modify the single set of superimposed image data, and a third permission of a user to delete the single set of superimposed image data." Support for these amendments to independent claim 1 can be found in the originally filed Specification, at least at page 13, lines 26-37, page 14, lines 28-37, and page 17, lines 1-29. Claims 2 and 9 depend directly from amended independent claim 1. Claim 11 has been amended in a manner similar to amended independent claim 1. Claims 12-17 depend from claim 11.

Applicants respectfully submit that McMillin fails to teach or suggest "a limiting part limiting use of the single set of superimposed image data in accordance with limitation information showing a limitation of use of the single set of superimposed image data," as recited in amended independent claim 1. Further, McMillin fails to teach or suggest that "the limitation information includes a first permission of a user to initiate the superimposing by the superimposing part, a second permission of a user to modify the single set of superimposed image data, and a third permission of a user to delete the single set of superimposed image data," as recited in amended independent claim 1. Accordingly, Applicants respectfully submit that amended independent claim 1 and claims 2 and 9, which depend therefrom, patentably distinguish over the prior art and are in condition for allowance.

Independent claim 11 has been amended to recite features similar to amended independent claim 1. Thus, as McMillin fails to teach or suggest "limiting use of the single set of superimposed image data in accordance with limitation information showing a limitation of use of the single set of superimposed image data" or that "the limitation information includes a first permission of a user to initiate the superimposing, a second permission of a user to modify the single set of superimposed image data, and a third permission of a user to delete the single set of superimposed image data," as recited in amended independent claim 11. Accordingly,

Applicants respectfully submit that amended independent claim 11 and claims 12-17 depending therefrom patentably distinguish over the prior art and are in condition for allowance.

REJECTION UNDER 35 U.S.C. §103

In the Office Action at page 4, numbered item 7, claims 19-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over McMillin. The rejection is traversed and reconsideration is requested.

Applicants respectfully submit that claims 19-25 patentably distinguish over the prior art for similar reasons as claims 11-17 and, therefore, claims 19-25 are in condition for allowance.

In the Office Action at pages 4-5, numbered item 8, claims 3-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over McMillin as applied to claim 1, and further in view of U.S. Patent No. 6,594,405 to Flannery. The rejection is traversed and reconsideration is requested.

As discussed above, Applicants respectfully submit that amended independent claim 1 patentably distinguishes over McMillin. As claims 3-8 depend either directly or indirectly from amended independent claim 1, Applicants respectfully submit that claims 3-8 patentably distinguish over McMillin for at least the same reasons as amended independent claim 1. Further, Applicants respectfully submit that Flannery also fails to teach or suggest "a limiting part limiting use of the single set of superimposed image data in accordance with limitation information showing a limitation of use of the single set of superimposed image data" or that "the limitation information includes a first permission of the user to initiate the superimposing by the superimposing part, a second permission of a user to modify the single set of superimposed image data, and a third permission of a user to delete the single set of superimposed image data, as recited in amended independent claim 1. Accordingly, Applicants respectfully submit that McMillin and Flannery, taken alone or in combination, fail to teach or suggest all of the features of dependent claims 3-8. Thus, Applicants respectfully submit that claims 3-8 patentably distinguish over the prior art and are in condition for allowance.

In the Office Action at pages 5-6, numbered item 9, claims 10, 18, and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over McMillin in view of U.S. Patent No. 6,370,280 to Cok, et al. The rejection is traversed and reconsideration is requested.

Amended independent claim 10 is directed to a data converting apparatus. In relevant part, amended independent claim 10 recites that "the limitation information includes a first permission of a user to initiate the superimposing by the superimposing part, a second permission of a user to modify the superimposed predetermined form, and a third permission of

a user to delete the superimposed predetermined form." Support for this amendment to independent claim 10 can be found in the originally filed Specification, at least at page 13, lines 26-37, page 14, lines 28-37, and page 17, lines 1-29. Independent claims 18 and 26 have been similarly amended.

Applicants respectfully submit that McMillin fails to teach or suggest that "the limitation information includes a first permission of a user to initiate the superimposing by the superimposing part, a second permission of a user to modify the superimposed predetermined form, and a third permission of a user to delete the superimposed predetermined form," as recited in amended independent claim 10. Cok, et al. teaches the generation of an ENABLE/DISABLE control signal, but fails to teach or suggest limitation information as recited in amended independent claim 10. For at least these reasons, Applicants respectfully submit that McMillin and Cok, et al., taken alone or in combination, fail to teach or suggest all of the features of amended independent claim 10 and amended independent claims 18 and 16, which have been amended to recite features similar to those of claim 10. Accordingly Applicants respectfully submit that amended independent claims 10, 18, and 26 patentably distinguish over the prior art and are in condition for allowance.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

Serial No. 09/537,342

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: David M. Pitcher
David M. Pitcher
Registration No. 25,908

1201 New York Ave, N.W., Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501